

## **REMARKS**

Applicants have now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of June 22, 2005.

Reconsideration of the Application is requested.

### **The Office Action**

In the Office Action mailed June 22, 2005, the Examiner rejected claims 1-8, 11, 13-14, and 16-24 of the present invention. The Examiner stated that Applicants' arguments with respect to claims 1-24 had been considered, but were moot in view of the new grounds of rejection. The Examiner rejected claims 1-8, 11, 13-14, and 16-24 as being unpatentable over U.S. Patent No. 6,621,589 to Al-Kazily et al (Al-Kazily) in view of U.S. Pub. No. US 20010025274 to Zehr et al (Zehr). Examiner allowed claim 15.

In view of the remarks set forth herein, Applicants respectfully submit that all pending claims 1-8, 11, 13-14, and 16-24, are in condition for allowance.

Claims 1-8, 11, and 13-24 remain in this application.

### **The subject invention**

For purposes of review, the subject invention is particularly applicable to an augmented operating system printing architecture that allows a user to select a charge account to be billed for each print job. The subject invention also facilitates printing to multiple recipients, especially when using a fax/modem printer device as the selected printer. It is a particular feature of the invention that the augmented printing architecture allows a user, at the time that the user initiates the print job, to set print job attributes for both accounting purposes and for selecting multiple individual recipients to receive the print job.

As explained in more detail below, these novel features are particularly important in distinguishing the invention from the teachings of the cited Al-Kazily and Zehr references.

### **The cited art**

Al-Kazily et al (Al-Kazily), U.S. Patent 6,621,589, discloses a centralized print system whereby at print time a user selects only the processing attributes for the print job,

instead of selecting a printer as is typically done in the art. The centralized print system uses those selected print job processing attributes to match the print job with a printer that can best handle and execute the print job. Al-Kazily discloses print job processing attributes such as duplex or n-up printing (col. 1, line 54), fastest device (col. 2, line 4), appropriate media (col. 2, line 5), stapling (col. 7, line 7), color (col. 7, line 10), or black and white (col. 7, line 36.) Although Al-Kazily describes matching the print job to the most appropriate printer dependent upon attributes relating to the *speed and quality* of the finished product (i.e., the print job), Al-Kazily does not disclose using print job attributes to manage the *accounting and delivery to multiple individual recipients* for print jobs.

Zehr et al (Zehr), U.S. Patent Application 09/781,129, discloses an electronic-to-physical mail system for reducing costs for mass mailings sent via the U.S. Postal Service. A user transmits an electronically message to a system disclosed by Zehr, which prints and mails the message to the intended group of recipients. Targeted advertisements are added by third parties who in turn help pay for the cost of mailing and printing. However, Zehr's system for defraying mailing costs to the sender does not disclose or fairly suggest providing a means for generating accounting information for each print job that can be later charged back to a client or project. One skilled in the art would not look to Zehr for generating accounting information for each individual print job for the following reasons: (a) Zehr does not disclose or fairly suggest user selectable *charge account codes* selected at print time by the user for clients or specific projects, but instead discloses generalized charge accounts for the sender and advertisers; (b) the subject invention relates to *allocating* costs to the appropriate *party or project* for billing purposes, not *defraying* costs to the *sender* as in Zehr; (c) the subject invention generates charges for *printing or faxing* documents, whereas Zehr reduces charges for *mailing*; and (d) one would not want Zehr's advertisements on documents printed in the normal course of business, which limits Zehr's utility to mass mailings.

#### Rejection under § 103(a)

The Examiner rejected claims 1-8, 11, 13-14, and 16-24 under 35 U.S.C. §103(a) as being unpatentable over Al-Kazily in view of Zehr.

**Independent claims 1, 6 and 11; dependent claims 2-5, 7-8, and 13:**

For Independent Claims 1 and 6, the Examiner argues that Al-Kazily meets all of the claimed limitations except for the limitation wherein the plurality of print job attributes included print job accounting information; the print accounting information including a charge account code, wherein the agent service is adapted to retain the charge account code for collection by a business-to-business accounting system. The Examiner states that Zehr discloses a plurality of print job attributes including print job accounting information; the print accounting information including a charge account code (Zehr page 3, ¶ 0036, lines 1-10), wherein the agent service is adapted to retain the charge account code for collection by a business-to-business accounting system (Zehr page 4, ¶ 0040). As motivation, the Examiner states that Zehr is in the same field of endeavor and teaches the way attributes or print job “email” includes cost attributes; the cost attributes being “used by the corporate accounts to further optimize the printing of a job [in a] network environment”.

However, the cited sections of Zehr do not disclose or fairly suggest a charge account code that is a print job attribute communicated from the client to the server. Applicant’s disclosure states that at the time of printing, the user is presented a dialog box for the user to enter print job accounting information such as a charge account code. (See specification Page 7, line 28 – Page 8, line 11.) The charge account code is transmitted across the network to the print server as one of the print job attributes. (See specification Page 8, lines 19-25.) Applicant’s claim 1 sets forth that the “agent service on the printer server [receives] ... the print job attributes communicated from the client”, the “print job attributes include print job information”, and the “print job accounting information [includes] a charge account code”. There is no recitation in Zehr of a charge account code that is a print job attribute communicated from the client to the server. Zehr discloses general charge accounts for the sender, such as “preapproved corporate accounts” (Zehr page 4, ¶ 0040), but Zehr does not disclose that this is communicated by the client to the print server as a print job attribute. Additionally, claim 1 claims a print driver with “enhancements for collecting a plurality of print job attributes when a print job is initiated on a client”. As described below, all of Zehr’s activity with charge attributes occurs outside of the client.

The charge attributes in Zehr do not originate from the client, but rather the Local Production Facility (LPF) which stores the “attribute database”. The server is “responsive

to automatic queries within *local* network of equipment at the LPF site as well as manually entered data." (Zehr page 2, ¶ 0031.) (Emphasis added.) In other words, the charge attributes cited by the examiner are not communicated by the client when a print job is initiated, but rather are only used in the later interaction between the Service Pod and Local Production Facility. In Zehr, when a user initiates a print job on the client, the print job is transmitted to the service pod, a server (Zehr page 2, ¶ 0030.) There is no recitation in Zehr of any charge account attribute when the print job is initiated on the client. The query engine on the service pod dynamically determines the best Local Production Facility to print the job (Zehr page 2, ¶ 0031.) Zehr then discloses that "cost attributes" can be changed at the Local Production Facility by the operator via a web interface with a service pod (Zehr page 3, ¶ 0036, lines 1-10). By lowering the cost per impression or advertisement (Zehr page 2, ¶ 0035), the Local Production Facility can "bid" for jobs (Zehr page 2, ¶ 0036). The cost attribute is therefore not used for "*allocating direct costs to projects and other client matter*" as in applicant's disclosure (see specification Page 8, lines 8-11) (emphasis added), but rather is a dynamic value that the operator can modify to "bid" for jobs (Zehr page 2, ¶ 0036). Zehr recites that the service pod can shunt the print job to the best Local Product Facility based on these "dynamic factors", such as the cost attribute (Zehr page 2, ¶ 0038), so the cost attributes are not necessarily fixed as would be desirable in a business-to-business accounting system.

Therefore the charge account attributes cited by the examiner are not generated by the client when the print job is initiated, but rather are: (a) set in the Local Production Facility; (b) stored in the Local Production Facility; and (c) communicated between the service pod and the Local Production Facility, and not the client. The charge account attributes are therefore not analogous either in form or function to applicant's print job accounting information. One skilled in the art would not combine Al-Kazily and Zehr and arrive at print job accounting information communicated by the client that is suitable for collection by a business-to-business accounting system as described in applicant's disclosure.

Applicant respectfully submits that independent claims 1 and 6 as well as claims dependent thereon (claims 2-5 and 7-8) are currently in condition for allowance with respect to Al-Kazily in view of Zehr.

For similar reasons as above, independent Claim 11 and dependent claim 13 are

also in condition for allowance with respect to Al-Kazily in view of Zehr.

**Independent claim 14:**

The Examiner argues that Al-Kazily meets all of the claimed limitations except for the limitation wherein the plurality of print job attributes included distribution information; the distribution information including information associated with sending the print job to multiple recipients of the print job.

The Examiner cites Zehr page 4, ¶ 0043 as disclosing the sending of the print job to multiple recipients, but that paragraph pertains to selection of advertisers. Examiner's motivation to combine is that Zehr teaches the way attributes or print job "email" includes cost attributes; the cost attributes being "used by the corporate accounts to further optimize the printing of a job [in a] network environment". Examiner's motivation appears to be a copy of an earlier motivation for print job accounting information and is not applicable to distribution information. Applicant respectfully submits that absent a proper suggestion or motivation to combine, independent claim 14 is allowable. In order to move prosecution forward, applicant will also traverse the examiner's rejection, but in doing so does not concede that examiner's suggestion or motivation to combine is proper.

Zehr teaches away from using job print attributes entered *when the print job is initiated* to select the desired recipients. In Zehr, a message sender prints a single message (or document) to the printer; a Zairmail print driver forwards the single message across the internet to a service pod (Zehr page 2, ¶ 0030); and the service pod queries a user database to generate the addresses used to physically address the mailings (Zehr page 2, ¶ 0031.) The user database, or recipient database, is preconfigured with group names, recipient names, email addresses, physical mail addresses, demographic information, and mail cost information (Zehr page 7, ¶ 0067). Zehr functions similarly for its email version, which also user database on the service pod (Zehr page 5, ¶ 0054.) In both the printer version and the email version, the selection of the recipients occurs in the service pod, and is not collected as a print job attribute when the print job is initiated.

Independent claim 14 is a method for sending a print job to a local print queue and not a network server. Because Zehr requires communication across a network with a remote service pod (see Zehr page 2, ¶ 0030 and page 5, ¶ 0054) to resolve the addresses of the recipients (see Zehr page 2, ¶ 0031), Zehr does not teach a method that

would work for a local print queue as claimed in claim 14. However, to preclude Claim 14 from being read broadly enough to allow distribution information to be obtained from a remote network server, Claim 14 has been amended to require that the distribution information required for each print job be obtained locally by the Windows® 2000.

Applicant respectfully submits that independent claim 14 is currently in condition for allowance with respect to Al-Kazily in view of Zehr.

**Independent claims 16, 20 and 23 and dependent claims 17:**

The Examiner argues that Al-Kazily meets all of the claimed limitations of independent claims 16, 20, and 23 except for the limitation wherein an agent service on the print server for receiving and at least temporarily retaining the print job attributes communicated from the client wherein the plurality of print job attributes include distribution information the distribution information including a first recipient name and a first telephone number associated with sending the print job as a fax to the first recipient.

Examiner cites Zehr page 4 paragraphs 0040, 0043, 0046 and 0047 as disclosing an agent service that at least temporarily retains print jobs attributes, the attributes including distribution information including a first recipient name and a first telephone number associated with sending the print job as a fax to the first recipient. However, none of the cited paragraphs recite, teach or fairly suggest sending the print job as a fax or retaining a telephone number as part of the distribution information. Nor is this recited in any other part of Zehr. Zehr teaches away from faxing in general, and instead is directed to allowing users to “send a message electronically to a number of recipients . . . and have the recipients receive the message as a physical mailing.” (Zehr “Abstract”.)

Additionally, upon viewing both references together, one skilled in the art would not reasonable imagine the subject matter of applicant’s disclosure. Neither reference cited by the examiner discloses or teaches anything relating to facsimile machines, with the exception of a single reference in Al-Kazily (col. 4 , line 26) in a mechanical listing of possible alternatives to printers without thought of whether they are actually applicable to his invention. There is no evidence of contemplation of the inventors or any enablement as to facsimile machines in either cited reference. The only motivation possible for adding reference Al-Kazily to reference Zehr in regards to fax machines is that found in Applicant’s own disclosure and claims. It is impermissible hindsight to take a single use of the word

facsimile and use it to re-create the entirety of applicant's disclosure.

Therefore, the applicant respectfully submits that independent claims 16, 20 and 23 as well as claims dependent thereon (claims 17-19, 21-22, and 24) are currently in condition for allowance with respect to Al-Kazily in view of Zehr.

**Claim 15 Allowed:**

Applicant gratefully acknowledges and appreciates Examiner's indication of allowable subject matter in claim 15.

### CONCLUSION

For the reasons detailed above, it is submitted that Claims 1-8, 11, 13-24 are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

No additional fee is believed to be required for this Amendment After Final. However, the undersigned attorney of record hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Deposit Account No. 24-0037.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Patrick R. Roche, at Telephone Number (216) 861-5582.

Respectfully submitted,

FAY, SHARPE, FAGAN,  
MINNICH & McKEE, LLP

11/16/05  
Date

  
\_\_\_\_\_  
Patrick R. Roche, Reg. No. 29,580  
1100 Superior Avenue, 7<sup>th</sup> Floor  
Cleveland, Ohio 44114-2579  
(216) 861-5582